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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,311	05/10/2001	Joseph Neev	101499.0001US1	7823
34284 7590 12/29/2006 ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			EXAMINER SHAY, DAVID M	
			ART UNIT 3735	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/854,311

Applicant(s)

NEEV, JOSEPH

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 12, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25, 28, 29, 31, 33-35, 37-40 and 45-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25, 28, 29, 31, 33-35, 37-40 and 45-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2006 has been entered.

Applicant has filed a substitute specification as a result of the examiner's objection to the originally filed specification. This specification has not been entered and the objection to the specification stands, as request for entry of the substitute specification has no statement that no new matter has been added and as such, is not in compliance with 37 CFR 1.125(b).

The disclosure is objected to because of the form of the specification for example that portion spanning pages 76-105. Beginning with the section labeled ADDITIONAL EMBODIMENTS on page 76 there are numbered paragraphs which appear to be in the form of claims, and refer back to prior paragraph numbers with the referent "claim" but do not appear to be intended to be claims as they are in the section preceding the legend "What is claimed is" and some (e.g. 141) are not in single sentence form and make reference to drawing figures. Further the section labeled "I claim" does not have the recitations therein commencing on a separate page. Applicant should extensively amend the disclosure to put it in proper form.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-23, 25, 28, 29, 31, 33-35, 37-40, and 45-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, the recitation "an intermediate substance in contact with the skin" specifically recites the skin as part of the device, and as such claims the body, thus this claim is indefinite. Amending the claim to read, in pertinent part "an intermediate substance adapted to contact the skin" would remedy this deficiency. Claims 46 and 47 are indefinite as it is unclear what structure the references to the passages in the specification are intended to imply.

Claims 21-23, 29, 31, 33, 34, 37, 45, and 47-49 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Eppstein et al (5,885,211).

See Figures 1-3, and column 12, line 39 to column 22, line 5, wherein the CPC is solid once the vehicle evaporates and is considered to be an insulator in the solid phase and a conductor in the gaseous phase.

Claims 25, 28, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eppstein et al (5,885,211). Eppstein et al (5,885,211) teaches a device as claimed except the particular intermediate substance. It would have been obvious to the artisan of ordinary skill to employ the various intermediate materials such as agar and tracing paper, since these are equivalents to the liquids and solids of Eppstein et al (5,885,211) as they can all conform to the tissue surface and retain an absorbing substance; are not critical; and provide no unexpected result, and to employ other forms of energy such as electron beams and X-rays, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result and can be absorbed to create heat, thus producing a device such as claimed.

Claims 38-40, 49-51, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eppstein et al (5,885,211) in combination with Baker et al. Eppstein et al (5,885,211) teaches a method as claimed except the removal of blemishes. Baker et al teach the desirability

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of removing blemishes by ablating very thin layers of tissue. It would have been obvious to the artisan of ordinary skill to employ the thin layer of tissue removal steps of Eppstein et al (5,885,211) in the method of Baker et al, since this allows the ablation of extremely thin layers of tissue and thus affords greater precision in tissue removal, or to employ the blemish removal method of Baker et al in the method of Eppstein et al (5,885,211), since this would provide the dual functionality of removing the blemish, while still enabling the removal of analytes, or, alternatively, the infusion of drugs which would help treat the blemish, thus producing a device such as claimed.

Applicant's arguments with respect to claim s 21-23, 25, 28, 29, 31, 33-35, 37-40, and 45-54 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David M. Shay", with a stylized flourish at the end.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330